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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,556	11/02/2000	William C.Y. Lee	G&C 139.141-US-UI	8737

22462 7590 06/15/2004

GATES & COOPER LLP  
HOWARD HUGHES CENTER  
6701 CENTER DRIVE WEST, SUITE 1050  
LOS ANGELES, CA 90045

EXAMINER

JUNG, MIN

ART UNIT PAPER NUMBER

2663

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/705,556

Applicant(s)

LEE ET AL.

Examiner

Min Jung

Art Unit

2663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-16 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 7 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3, 5-6, 8, 10-13, 15-16, and 18, 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Gorsuch, US 6,526,034.

Gorsuch discloses a dual mode subscriber unit and system for communication using a wireless LAN or a cellular network.

Specifically, regarding claims 1 and 11, Gorsuch teaches a wireless communication system including a cellular network (digital cellular mobile telephone system shown by cells 601 and 603 in Fig. 5, and described at col. 8, lines 20-32), a wireless local loop network (wireless LAN 607 having coverage areas of 613A and

613B) connected to the cellular network (connection is through the public network cloud 619 (which would include MSC, etc.) shown in Fig. 5, col. 8, lines 33-46), and a dual enabled device operating on both the wireless local network and the cellular network, wherein the device uses the wireless local loop network for communication, if available, and otherwise uses the cellular network for communications (terminal 615 shown in Fig. 6, col. 10, lines 44-54).

Regarding claims 2 and 12, Gorsuch teaches a gateway connecting the wireless local loop network to the cellular network (gateway 609A connecting the wireless LAN to the public network 619).

Regarding claims 3 and 13, Gorsuch teaches at least one master device (hubs 611A and 611B) that can communicate wirelessly with at least one slave device (terminal 615).

Regarding claims 5 and 15, the hubs (master device) in Gorsuch can communicate with the cellular network as shown by the connection from the LAN 607 to the public network (Fig. 5, col.8, lines 33-38).

Regarding claims 6 and 16, the terminals 615, 617 (slave device) in Gorsuch can communicate with the cellular network (Fig. 5, col. 8, lines 50-53, and 61-64).

Regarding claim 8 and 18, Gorsuch shows the wireless coverage area where both the wireless LAN and the cellular network are available (Fig. 5).

Regarding claims 10 and 20, Gorsuch teaches discovery and registration process to identify whether to use either the wireless local network or the cellular network (col. 8, line 54 – col. 9, line 27, and col. 10, lines 43-50).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorsuch in view of Yegoshin, US 6,711,146.

Regarding claims 4 and 14, Gorsuch fails to specifically teach the devices forming a logical connection, virtual local area network. However, since the terminals 615 and 617 are wireless devices, it is inherent that these devices are mobile, and therefore, the terminal 617 can be moved to be within the range of wireless LAN coverage areas of 613A or 613B, in which case some kind of logical connection is necessary to be associated with the LAN hub 611A or 611B. In the same field of the invention, Yegoshin teaches a dual mode device capable of both cell phone communication and telephone communication on a LAN. In Yegoshin, IP LANs are established at organization sites such that a temporary IP address is assigned to a dual mode device that logs onto the LAN, thus creating logical connection. See abstract. It would have been obvious for one of ordinary skill in the art at the time of the invention to implement Gorsuch employing a logical connection among the devices forming a virtual local area network as taught by Yegoshin because the mobile nature of the network

Art Unit: 2663

would lead to the benefit of logical connection, and the teaching of wireless ISP and TCP/IP (col. 5, line 51 – col. 6, line 3) in Gorsuch also implies the logical connection.

5. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorsuch in view of Schellinger et al., US 5,842,122 (Schellinger).

Regarding claims 9 and 19, Gorsuch fails to specifically teach the handoff operation between the wireless LAN and the cellular network. However, Gorsuch talks about selecting the cellular network after failure to communicate over the wireless LAN for any reason (col. 10, lines 60-64). In the same field of the invention, Schellinger teaches a dual mode cellular cordless portable radiotelephone (abstract), and handoff between a cordless telephone system and a cellular telephone system (col. 6, line 64 - col. 7, line 6). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to incorporate the handoff taught by Schellinger when implementing the network selecting function of Gorsuch so that such selecting (implemented as handoff) can take place during the communication for selection of different network.

### ***Allowable Subject Matter***

6. Claims 7 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: Prior art fails to teach or fairly suggest a system or a device as recited including

Art Unit: 2663

the features of "data may ricochet within the wireless local loop network, such that master or slave devices that are cellular-enabled can relay data for master or slave devices that are not cellular-enabled".

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Ramaswamy patent, the Lu et al. patent, the Larsson et al. patent, the Zicker patent, the Rousseau et al. patent, the van der Tuijn et al. patent, the Chow et al. patent, and the Bursztejn et al. patent are cited for further references.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Jung whose telephone number is 703-305-4363. The examiner can normally be reached on Monday-Friday, 7AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 703-308-5340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2663

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ  
June 4, 2004



Min Jung  
Primary Examiner